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Off. Act. Dated: 03/03/2005

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the foregoing amendments claims and the discussion presented herein.

The undersigned calls to the attention of the Examiner that the prior attorney of record has closed his practice and is no longer responsible for prosecuting this application. A revocation of power of attorney and new power of attorney is submitted herewith. All further correspondence should be directed to the undersigned at the address and telephone number set forth below.

1.   Rejection of Claims 1-51 under 35 U.S.C. § 112, first paragraph.

Claims 1-51 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. More specifically, the Examiner indicates that the subject matter of those claims was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The rejection of Claims 1-51 was based on the following claim element, which had been added to each of the independent claims in the prior response:

"wherein the one or more time stamps represents content that is broadcasted and wherein identification of the content is independent of detection by the data marker device of a frequency at which the content is broadcasted."

In the prior response, the Applicant made a bona-fide attempt to advance the case by more clearly reciting the differences between the Applicant's invention and that of Tarbouriech et al., which was cited by the Examiner. This was done to advance prosecution even though the Applicant believed that the language of the claims prior to amendment distinguished the case over the relied-upon reference.

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In the instant Office Action, the Examiner contends that said *"identification of the content being independent of detection by the marker device of a frequency at which the content is broadcasted"* is not described in the specification. However, FIG. 2 clearly illustrates that the data marker device has NO NEED of detecting the frequency at which the content was broadcast.

The Applicant's prior related applications, which were incorporated herein as recited on page 7 of this application, described these external RF and audio sensing means in great detail. Implementing the device to require the user to select the desired event out of multiple retrieved events allows Applicant's invention to be implemented in the small footprint, low cost, keychain device as described in the background of the invention. There is no necessity of detecting the broadcast source because the user can post-select the source associated with the time marker. This is why the present unit can also be utilized for marking non-broadcast events (see page 14, lines 28-31); this would not be possible if a broadcast frequency or other definitive input were required for each mark as taught by Tarbouriech et al.

To provide additional clarity, the Applicant has amended Claims 1, 21, 44 and 51. The last element of those claims, which was added in the prior response and which prompted the rejection under 35 U.S.C. § 112, first paragraph, has been eliminated. Instead, the Applicant has amended the claims using language which is consistent with the specification.

Therefore, the Applicant respectfully submits that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

2.   Rejection of Claim 51 under 35 U.S.C. § 102(e).

Claim 51 was rejected under 35 U.S.C. § 102(e) as being anticipated by Tarbouriech et al. (U.S. No. 6,650,877).

In response, the Applicant has amended Claim 51 to more clearly distinguish over Tarbouriech et al. As amended, Claim 51 clearly recites that only the time stamps

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and device identification are stored to provide for event identification: *"...in a portable device as the only event identifiers stored"*. This clearly distinguishes over Tarbouriech et al., which requires additional sense inputs, such as frequency, or user channel selections, to be stored with a time value in preparation for retrieving event information.

Claim 51 now also recites an additional "means plus function" element which replaces an earlier wherein clause; namely *"means for retrieving event information in response to time information and said device identification code stored in said portable device by said means for storing"*.

In contrast, Tarbouriech et al. does not teach the creation of markers without sensing physical observations, or alternatively receiving user input on the physical observation, in particular broadcast frequency, or channel, which are stored in the device marker in conjunction with time information. The need for registering this information in the Tarbouriech et al. device puts practical limits on the ability to manufacture a device in a small size at low cost; which is a primary purpose described in the background of Applicant's invention. One of ordinary skill in the art would also realize that the need for this additional circuitry, or user inputs, can limit integration of the functionality described herein within other devices, such as cells phones and the like, which may not have these capabilities. This is an important point. Note that the Applicant describes the importance of being able to create a keychain sized device as recited in the background; see page 1, line 33 through page 2, line 10. Unlike the teachings of Tarbouriech et al., this system does not require frequency generation, frequency receiving, or a microphone, as can be seen from FIG. 2.

Proper support of an anticipation rejection requires that every claim element must be taught or inherent in a single prior art reference. (MPEP) §706.02a. Accordingly, Claim 51 is not anticipated since Tarbouriech et al. requires the storage of more than the time stamp and device identification code within the marker device.

Therefore, the rejection of Claim 51 should be withdrawn.

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3.   Rejection of Claims 1-13, 16-32, 35-37 and 40-50 under 35 U.S.C. § 103(a).

Claims 1-13, 16-32, 35-37 and 40-50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tarbouriech et al. (U.S. Pat. No. 6,650,877) in view of Doyle et al. (no patent reference number provided). Claims 1, 21 and 44 are independent.

After carefully studying the grounds for rejection, the Applicant responds as follows.

(a)   Claim 1. In the office action of 10/07/2004, the Examiner objected to Claims 14, 15, 33, 34, 38 and 39 indicating that they would be allowable if they were both rewritten in independent form, and the rejections of 35 U.S.C. §112, second paragraph, were overcome as to Claims 33, 34, 38 and 39. In the Applicant's response to that Office Action, the Applicant did not rewrite the claim in independent form but attempted to materially advance the application by amending the independent claims to further distinguish over the cited art.

In the instant response, the Applicant has incorporated the limitations of Claim 14, as well as intervening Claims 13 and 12 into Claim 1 (the independent base claim) and cancelled Claims 12, 13 and 14. In doing so, the Applicant found that Claims 12 and 13 contained redundant and unnecessary elements, which was taken into account when amending Claim 1. As a result, Claim 1 was returned to its original form (prior to amendment in response to the 10/07/2004 Office Action) and the substantive material of Claim 14 and intervening Claims 12 and 13 was added to Claim 1.

Therefore, amended Claim 1, as well as Claims 2-11 and 15-20, which depend therefrom, should be in condition for allowance.

(b)   Claim 21. Independent Claim 21 is drawn to a system for identifying a time specific event.

In considering the elements of independent Claim 21, it should be appreciated that only time stamps are required for marking events in the present system while only time stamps and device identification are stored in the data marker device; no source designation, such as broadcast channel, needs to be stored in the data marker, or are

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required for retrieving event information. It can be readily seen in FIG. 2 that there is no information that needs to be collected for storage in the data marker about the broadcast station, or collected in advance from a user in preparation for marking an event.

This is also reflected throughout the specification wherein all storage is described pertaining to the time stamps and device identification information. Retrieval of event information for the present system is performed in response to the information in the user device account after uploading the timestamps into the user device account, which can contain additional information. It will be appreciated that the server can thus allow the user to select any of the available content that corresponds to each given time slot; such as ranked by defaults set by the user in the user account. It would be apparent from this discussion that user account setup can contain information about how to recognize the timestamps, such as what geographic area, prioritized station list and so forth.

Turning to the language of Claim 21 as reflected in the specification, it can be seen that only time stamps and device identifiers are described as being stored in the data marker throughout the specification, such as at page 2, lines 14-15; page 2, lines 21-23; page 3, lines 1-3; page 3, lines 10-11; page 10, lines 25-28 and so forth. The accessing of the event information is performed through the user account such as described on page 7, lines 11-12; page 9, line 29-31; and elsewhere throughout the specification.

The Applicant has amended Claim 21 to more clearly recite the operation of Applicant's device, which requires only the time stamp for marking events and communicates only a time stamp and identifier to the user terminal. Therefore, the present invention eschews the need for other physical inputs such as either frequency or user event type selections prior to registering the mark, a clear departure from Tarbouriech.

It can be readily seen that the obviousness rejection is not applicable to amended Claim 21. Tarbouriech et al. does not store only time stamps for identifying the event within the data marker device, in clear contrast to Claim 21 which recites: "*data marker device configured to store an event based only on one or more time stamps generated responsive to a user input operation*".

Consequently, Tarbouriech et al. fails to teach the foregoing aspect of the Applicant's invention. The combination with Doyle et al. does not correct this shortcoming.

Although the foregoing is clearly sufficient to overcome the relied-upon reference, the Applicant also believes that it would be improper to combine Tarbouriech et al. with Doyle. The result of the combination between Tarbouriech et al. and Doyle does not result in the Applicant's invention, and there is no suggestion, motivation, or incentive for attempting the combination without the benefit of hindsight based on Applicant's own invention.

More specifically, the Applicant describes the calculation of time on the user terminal, such as described on page 11, lines 1 - 29. This section of the instant application describes how the time stamp values stored as markers are subtracted from the stop time values known only at the user terminal. A real time clock value is received from the server corresponding to the stop time to equate the time offset calculation to a real time value. Applicant believes this will be readily understood by one of ordinary skill in the art. Amended Claim 21 recites the use of the time stamp information as described above, to assure proper understanding of this aspect.

Therefore, the purpose for the combination of references is not met, especially in view of the claim amendment, as the calculation is performed for a different purpose which is not described by Tarbouriech et al. Furthermore, the combination of Tarbouriech et al. with Doyle et al. still does not result in applicant's invention as claimed.

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Therefore, amended Claim 21, and the claims which depend therefrom, are not obvious in view of the cited references and the rejection should be withdrawn.

(c)   Claim 44. Independent Claim 44 is drawn to a method of identifying physical events, and Claim 44 has been amended to further clarify elements of the invention in response to the rejection.

The elements of amended Claim 44 do not comport with the teachings of Tarbouriech et al. Specifically, Claim 44 recites a method comprising "receiving identification of an event based only on one or more time stamps stored in a data marker device". This limitation is clear from the text and the fact that no other sources are available for encoding information in this embodiment described in FIG. 2.

In contrast, Tarbouriech et al. teaches that an additional physical identifier is also necessary, such as the broadcast frequency, or a broadcast identification entered by the user. Therefore, Tarbouriech et al. always requires some specification for the source which is received from a data marker device, whether it be a frequency identification determined electronically, a frequency identification entered manually into the marker device and so forth.

It should be readily understood that the device described by the instant application can be made much smaller and less expensively, as discussed by the Applicant in the background of the invention, as it does not require any of these physical sense attributes for encoding in the data of the data marker. The method of Claim 44 is a great advantage in creating a system that allows utilizing a small portable marker device in either standalone configurations or when the functionality is integrated within other devices, (e.g., cell phones, and the like).

Again, the foregoing should be considered sufficient to overcome the relied-upon reference. The Applicant also believes that the combination with Doyle does not provide any support for rejecting the method recited in Claim 44. A combination with Doyle certainly would not render obvious "receiving identification of an event based only on one or more time stamps stored in a data marker device" as this is an aspect clearly

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not addressed by Doyle, which does not even describe any form of data marker device. In addition, the processing of reference time should not be considered obvious in view of a combination with Doyle, as there is no suggestion, motivation, or incentive for attempting the combination without the benefit of hindsight based on Applicant's own invention.

Furthermore, Doyle is apparently drawn to a method of offloading processing from a server to a client. In contrast, the Applicant's Claim 44 describes method steps for determining time information which is computed using a time reference supplied by the server and time stamp information. Nothing described by Doyle or Tarbouriech et al. comports with this aspect.

Utilization of the user device account is further recited in Claim 44 into which the time information and device identification codes are sent, and whose information is used to retrieve physical event information. The claim also describes the use of the reference time information in computing time information. As a result, the process is thus clearly defined by this amended method claim.

Therefore, it has been shown that Tarbouriech et al. does not meet the limitations of Claim 44, and that a combination with Doyle still does not meet the limitations of Claim 44. Accordingly, the rejection of Claim 44 and the claims which depend therefrom should be withdrawn.

4.   Cancellation of Claims 12-14.

Dependent claims 12-14 were incorporated into independent Claim 1, and these dependent claims cancelled.

5.   Amendment of Claims 1, 3, 6-7, 20-22, 25-26, 30-32, 36-37, 43-45 and 47-51.

Claim 1. Independent Claim 1 was amended to incorporate elements from original dependent Claims 12, 13 and 14.

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The material of Claim 12 was incorporated after correcting the redundant recitation of time stamps to "number of time stamps" as found in the specification at page 4, lines 18-21, and elsewhere. In addition, the material of Claim 13 was incorporated after removal of unneeded references to the type of transmission.

Claims 3, 20, 22 and 43. Claims 3, 20, 22 and 43 are dependent claims which were amended to break up the material into two "wherein" clauses to improve readability.

Claim 5. Dependent Claim 5 was amended to correct a typographical error, replacing the term "and" with "or" in the list of alternative forms of device identification codes.

Claims 6 and 25. Claims 6 and 25 were amended to describe how the time stamps can be stored, specifically as based on an arbitrary running clock (i.e. elapsed time).

Support for the use of an arbitrary running clock for storing the time stamps is found in the specification, such as at page 10, lines 25-31; page 11, lines 1-11; and elsewhere.

Claims 7 and 26. Claims 7 and 26 were amended to replace the GMT time information, which was provided as an example in the specification, with the more generic "real time information". Support for the use of real time information is described in the specification, such as at page 11, lines 1-11.

Claim 9. Dependent Claim 9 was amended to recite with greater clarity the nature of the request signal. Support is found in the specification, such as at page 11, lines 4-11.

Claim 21. Independent Claim 21 was amended to correct the preamble to recite statutory matter, and to amend the body of the claim to recite with particularity limitations of Applicant's device. Specifically, the following changes were made.

The data marker device is recited with more clarity "to store an event based only on one or more time stamps generated responsive to a user input operation". The

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redundant portion of the claim element was removed, as was the "device identification code" reference as it identifies the marker device and not data associated with each bookmarked event (i.e., see page 4, line 18-21).

The data marker device is described as "<u>configured for communicating said time stamps and an identification code over</u> a data network", instead of appearing to include a data network. Other elements of the claim were amended to follow this same network operability paradigm. Support is seen throughout the specification, including page 7, lines 11-12: *"In this manner, cradle 102 may be connected to user terminal 103 accessing the user's electronic music marker device account over an internet connection."*

The use of the reference time information was recited with greater particularity, specifically: "<u>to determine a time information corresponding to each of the one or more time stamps by subtracting time elapsed from the marked time stamps from the device stop time and subtracting this amount from the reference time value received from the server.</u>" Support for the computation of time stamp information is found in the specification, including at page 11, lines 1-25.

The claim also recites the use of the user device account and how event information is retrieved based only on the time stamps and recites "<u>wherein said user terminal is configured to access a user device account through which the user retrieves information for events which were stored in the data marker device, having a device identification code, as said time stamps</u>". Support for the user device accounts is found throughout the specification including page 7, lines 10-12; FIG. 6 and description of FIG. 6, page 9, lines 29-31, page 10, lines 1-8; page 14, lines 29-31; and elsewhere.

<u>Claim 30</u>. Claim 30 was amended to correct syntax by removing an improper "is".

<u>Claim 31</u>. Claim 31 was amended in the same manner that original Claim 12 was modified as incorporated within Claim 1. Support can be found in the specification, including page 11, lines 26-28.

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<u>Claims 32 and 37</u>. Claims 32 and 37 were amended to remove unnecessary recitation of a specific transmission instance (see page 11, lines 26-29).

<u>Claim 35</u>. Claim 35 was amended to remove an unneeded and possibly confusing reference to a transmission from the user terminal.

<u>Claim 36</u>. Claim 36 was amended in the manner of Claim 12 prior to its incorporation within Claim 1. Support is found at page 11, lines 26-30.

<u>Claim 44</u>. Independent Claim 44 was amended to correct the preamble so as to recite statutory matter, and to amend the body of the claim to recite with particularity the limitations of Applicant's device. Specifically, the following changes were made.

To prevent any possible confusion the source or target of each communication was recited, such as "<u>from the data marker device</u>", and "<u>to a server configured to provide a real time reference</u>".

The generation of time information from the time stamps stored in the data marker device is further described as being "<u>computed based on the reference time information received</u>". Support for this is found in the specification such as at page 11, lines 1-25.

The data transmitted to the user device account was amended to eliminate the incorrect inclusion of the reference time information and to correct the "one or more" reference to "number of", as this is not a specifier of multiplicity but a value of a count indicating how many time stamp values are included; this is clearly described in the specification, such as at page 11, lines 26-31.

Utilization of the user device account is recited at the end of the claim, support for which can be found in the specification, such as at page 7, lines 10-12; FIG. 6 and description of FIG. 6, page 9, lines 29-31, page 10, lines 1-8; page 14, lines 29-31.

<u>Claims 45 and 47-50</u>. Claims 45 and 47-50 were amended to replace the less preferable "further including" with the more conventional "further comprising".

<u>Claim 51</u>. Independent Claim 51 was amended to recite the invention with greater particularity. Specifically the time stamps and device identifier are described as

being the only event identifiers stored in the means for storing. Support is found throughout the specification as only time stamps and device identifier are described as being communicated from the data marker device. In addition FIG. 2 depicts a circuit which does not register frequencies or other event specific data for storage with the time stamps.

The "wherein" clause added in a previous office action response, and found to be confusing, was replaced with an additional means element instead. Specifically, the claim now includes recitation of: "means for retrieving event information in response to time information and said device identification code stored in said portable device by said means for storing". Support for this aspect is described in the specification, such as at page 7, lines 10-12; FIG. 6 and description of FIG. 6, page 9, lines 29-31, page 10, lines 1-8; page 14, lines 29-31; and elsewhere.

6.   Amendments Made Without Prejudice or Estoppel.

Notwithstanding the amendments made and accompanying traversing remarks provided above, the Applicant has made these amendments in order to expedite allowance of the currently pending subject matter. However, the Applicant does not acquiesce in the original ground for rejection with respect to the original form of these claims. These amendments have been made without any prejudice, waiver, or estoppel, and without forfeiture or dedication to the public, with respect to the original subject matter of the claims as originally filed or in their form immediately preceding these amendments. The Applicant reserves the right to pursue the original scope of these claims in the future, such as through continuation practice, for example.

7.   Conclusion.

Based on the foregoing, the Applicant respectfully requests that the various grounds for rejection in the Office Action be reconsidered and withdrawn with respect to the presently amended form of the claims, and that a Notice of Allowance be issued for

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the present application to pass to issuance.

In the event any further matters remain at issue with respect to the present application, the Applicant respectfully requests that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this application.

Date: _____6/2/05_____

Respectfully submitted,
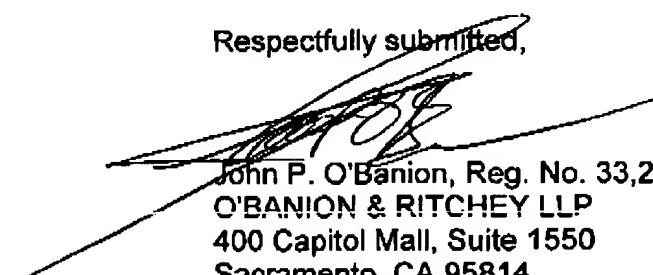
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